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| 10/574,109 | 03/31/2006 | Shinji Yoshida | 2006-0156A | 7173 |
| 513 7590 09/28/2009 WENDEROTH, LIND & PONACK, L.L.P. 1030 15th Street, N.W., Suite 400 East Washington, DC 20005-1503 | | | EXAMINER SCHLENTZ, NATHAN W | |
| | | | ART UNIT | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,109

Applicant(s)

YOSHIDA ET AL.

Examiner

Nathan W. Schlientz

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 and 4-16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/ISD)
Paper No(s)/Mail Date 3/31/06 and 10/22/07
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

Claims 1 and 4-16 are pending in the present application and are examined herein on the merits for patentability. No claim is allowed at this time.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 4, 5, 7-11 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Okada (JP 07-291699).

Okada discloses a termite-controlling concrete comprising a specific absorbing agent containing a termite-controlling agent (chlorpyrifos, creosote oil, or 8-hydroxyquinoline) absorbed therein and incorporating said absorbing agent with the termite-controlling agent into concrete (Abstract). Okada discloses adding the absorbent/termite-controlling agent with mortar, which added water to sand and cement, and the usual concrete, which added water to gravel, sand and cement, followed by mixing to homogeneity and solidifying ([0024]-[0025]).

2. Claims 1, 9-11 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 4-51506 U (Abstract only).

JP '506 discloses a time-hardening hardenable material (i.e., hydraulic material) containing a termiticide (Abstract). JP '506 discloses an earth floor continuously laid between a strip flooring and a bond stone over an underfloor ground, wherein the underground floor comprises a lower layer composed of the time-hardening hardenable material with termiticide and an upper layer comprising a time-hardening hardenable material containing a humidity-controlling agent (Abstract).

3. Claims 1, 9 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Allen et al. (Journal of Economic Entomology, 1961, 54(5), 1055-1056).

Allen 1961 disclose that concrete fabricated with a toxic agent that would cause mortality of termites through contact action might eliminate or reduce the problem of preventing termite movement over the concrete or through crevices in foundations (pg. 1055, right column, 2nd paragraph). Allen 1961 disclose that late in the summer of 1960, dieldrin, an insecticide highly toxic to termites, was incorporated into cement mixtures; wherein a wettable powder containing 75% dieldrin was added to water used in the preparation of the concrete (pg. 1055, right column, 4th paragraph).

4. Claims 1, 9 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Allen 1964 (Journal of Economic Entomology, 1964, 57(1), 26-29).

Allen 1964 disclose that a mixture of dieldrin-water and cement produces a concrete with a surface that is toxic to termites (pg. 26, left column, 1st sentence). The dieldrin-concrete mixtures comprise dieldrin, 75% wettable powder in water, and ready-mix cement (pg. 26, left column, 2nd paragraph).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1,148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
1. Claims 1 and 4-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (JP 07-291699) in view of Copling (US 4,308,068).

Determination of the scope and content of the prior art

(MPEP 2141.01)

The teachings of Okada are discussed above and incorporated herein by reference.

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Okada does not teach addition of a dirt component (i.e., clay or silt) in the termite-controlling concrete compositions, as instantly claimed. However, Copling teaches concrete compositions wherein clay and sawdust are incorporated within the concrete premix comprising sand, gravel, lime, and cement (col. 2, ln. 34-54). Copling teaches that addition of clay and sawdust in the concrete results in considerably lighter weight items that can be more easily handled, are resistant to termites, and are useful in building walls, floors, chimneys and the like (col. 3, ln. 1-19).

Finding of *prima facie* obviousness

Rational and Motivation (MPEP 2142-43)

Therefore, it would have been *prima facie* obvious for one of ordinary skill in the art at the time of the invention to incorporate clay into the termite-controlling concrete of Okada to get a more easily handled, termite-resistant concrete, as reasonably taught by Copling.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

2. Claims 1 and 4-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 4-51506 U (Abstract only) in view of Copling (US 4,308,068).

Determination of the scope and content of the prior art

(MPEP 2141.01)

The teachings of JP '506 are discussed above and incorporated herein by reference.

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

The abstract of JP '506 does not teach the make-up of the time-hardening hardenable material which contains a termiticide. However, JP '506 teaches the material being used as an earth floor in an underfloor damp-proof structure. Thus, it would have been obvious to use a concrete composition as the time-hardening hardenable material. Copling teaches standard concretes include Portland cement (col. 1, ln. 13-15). Copling further teaches concrete mixes comprising sand, gravel, lime, cement, sawdust, clay and water (col. 2, ln. 34-54), wherein the resulting concrete is considerably lighter in weight and can be more easily handled, are resistant to termites, and are useful in building walls, floors, chimneys and the like (col. 3, ln. 1-19).

Finding of *prima facie* obviousness

Rational and Motivation (MPEP 2142-43)

Therefore, it would have been *prima facie* obvious for one of ordinary skill in the art at the time of the invention to use concrete mixtures, such as those taught by Copling, as the time-hardening hardenable material in JP '506.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

3. Claims 1 and 4-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen 1961 (Journal of Economic Entomology, 1961, 54(5), 1055-1056) and Allen 1964 (Journal of Economic Entomology, 1964, 57(1), 26-29) in view of Copling (US 4,308,068).

Determination of the scope and content of the prior art

(MPEP 2141.01)

The teachings of Allen 1961 and Allen 1964 are discussed above and incorporated herein by reference.

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Allen 1961 and Allen 1964 do not teach the make-up of the cement mixtures to which the dieldrin was added. Copling teaches standard concretes include Portland cement (col. 1, ln. 13-15). Copling further teaches concrete mixes comprising sand, gravel, lime, cement, sawdust, clay and water (col. 2, ln. 34-54), wherein the resulting concrete is considerably lighter in weight and can be more easily handled, are resistant

to termites, and are useful in building walls, floors, chimneys and the like (col. 3, ln. 1-19).

Finding of *prima facie* obviousness

Rational and Motivation (MPEP 2142-43)

Therefore, it would have been *prima facie* obvious for one of ordinary skill in the art at the time of the invention to use concrete mixtures, such as those taught by Copling, as the cement mixtures of Allen 1961 and Allen 1964.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan W. Schlientz whose telephone number is 571-272-9924. The examiner can normally be reached on 8:30 AM to 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWS

/John Pak/
Primary Examiner, Art Unit 1616